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PATENT  
Attorney Docket No.: 020375-002710US

TOWNSEND and TOWNSEND and CREW LLP

By: /Dianna L. Smith/  
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE  
THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of:

John Joseph Mascavage, III, et al.

Application No.: 09/991,379

Filed: November 15, 2001

For: ONLINE PURCHASING METHOD

Customer No.: 20350

Confirmation No.: 2669

Examiner: Siegfried E. Chencinski

Art Unit: 3691

**APPELLANTS' REPLY BRIEF  
UNDER 37 C.F.R. § 41.41**

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This Reply Brief is submitted in response to the Examiner's Answer mailed September 3, 2008. The following remarks are intended to further focus the issues in this appeal.

The Appellants maintain that all pending claims are allowable because the record has not properly followed the Graham factors in making out the obviousness rejection. The record cites six references to reject claim 1, yet the references nevertheless fail to teach or suggest all claim elements; there is no analysis of the skilled artisan who would presumably know how to fit together the teachings of the different references; and the record does not clearly articulate the line of reasoning the skilled artisan would use. Instead, the Examiner's Answer still does not cite a reference for all elements, rejects the requirement to address the level of skill in the art, and fails to respond to the Appellant's reasoned arguments regarding the deficient motivation relied on in the record. Hence, the Appellants maintain that all pending rejections are improper.

The record has not identified a prior art reference that teaches or suggests, “from the funds transfer sever, interacting with the pop-up window to present a transaction amount in the pop-up window and receiving customer assent to the transaction amount,” as recited in claim 1 and similarly recited in claims 10 and 17. The Examiner’s Answer seeks to clarify the reasoning behind the portion of the rejection relating to this element. Apparently six different references, Wilf, Stein, Paltenghe, Daniels, Matyas, and AAPA, are required to construct this one element. Yet the Examiner’s Answer, like the record to date, still fails to address all aspects of the element and explain how the different teachings fit together to make the claim element.

More directly, Paltenghe’s wallet server (cited by the final Office Action as “a funds transfer server”), is discussed in isolation without any explanation of how the transaction amount (which the final Office Action credits to Paltenghe’s “implicit” teaching), is presented in Daniels’ pop-up window, even though Daniels does not teach a popup window having a transaction amount. In fact, no reference is cited for a popup window having a transaction amount presented therein. The cited references simply do not teach or suggest all the claim elements.

Moreover, the Examiner’s Answer appears to rely on a level of skill in the art as revealed in the references themselves, but fails to address how that skilled artisan would reconcile the flaws the Appellants have identified in the reasoning based on motivation. The Appellants maintain that the motivation upon which the rejections are based is illogical and would have been recognized as such, at least by an artisan having the level of skill implicit in the cited references. Specifically, the final Office Action of March 18, 2008, cites a single motivation, suggesting that this motivation is sufficient grounds for combining all six references. It is not. Stein, for example, directly contradicts the motivation “to overcome the reluctance of some users to transmit credit card information over the internet,” because Stein teaches doing just that. In other words, if the motivation is correct, the skilled artisan would look no further than the Stein reference itself to satisfy the motivation. No other reference would be needed. The Examiner’s Answer does not contradict this. Hence, the line of reasoning used by the Office Action to reject the claims is flawed.

In examining the pending claims, the Examiner appears to have used the Appellants' claims as a roadmap to word search for references that have words similar those used in the claims. Moreover, the undefined skilled artisan is left to know how the references would fit together in light of a motivation that the Appellants have demonstrated to be flawed. Accordingly, the Appellants maintain that the rejections of the independent claims are improper. All claims are, therefore, believed to be allowable, at least for the foregoing reasons.

Finally, regarding the rejections of claims 12 and 13, which depend from claim 10 and are believed to be allowable, at least for that reason, the Examiner's Answer does not cure the failure of the record to cite a reference that teaches the claim elements. The Examiner's Answer attempts to justify a conclusion that a teaching is implicit in a reference by citing examination guidelines relating to a rationale for combining being implicit in reference teachings. This is a misapplication of the law (which relates to implicit rational and not to implicit claim element teachings) to the situation here. Hence, the Appellants maintain that the rejections of claims 12 and 13 are improper.

Respectfully submitted,

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